REMARKS

Claims 1, 5-10 and 12-15 are pending in the instant application. Claims 1, 5-10 and 12-15 have been rejected. Claim 1 has been amended. No new matter has been added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Rejection of Claims Under 35 U.S.C. 103(a)

Claims 1, 5-10 and 12-15 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Tischfield et al. (1999), in view of Balboa et al. (1996), Taylor et al. (1999), and Baracchini et al. (US Patent 5,801,154). The Examiner suggests that it would have been obvious to one of ordinary skill in the art to use the antisense sequences of Tischfield et al., ones that target the cDNA sequence of phospholipase A2 group V, and synthesize them with modifications as taught by Balboa et al., Baracchini et al., and Taylor, in order to inhibit expression of the gene. The Examiner suggests that motivation is provided by these combined teachings and the fact that Balboa et al. teach us of antisense *in vitro* to inhibit expression of murine phospholipase A2 group V and the role of this gene in a variety of biological processes. The Examiner suggests that a reasonable expectation of success is provided by

the teachings of Baracchini et al. and Taylor et al. in teaching that antisense to the 3'-untranslated region can be designed and that only a few oligos need to be screened before finding an active one. Applicants respectfully traverse this rejection.

At the outset, Applicants have amended the claims to recite that the antisense compounds are targeted to a specific nucleobase region within the 3'-untranslated region of phospholipase A2 group V. Support for this amendment to the claims can be found at Table 1 of the specification as filed where the starting point and stopping point of the region now claimed can be easily identified.

Tischfield et al. (1999) disclose mammalian phospholipase A2 nucleotide sequences and antisense sequences. Although the patent discloses several sequences that overlap with residues within SEQ ID NO: 3, nowhere does this patent teach or suggest antisense targeted to the specific nucleobase region within the 3'-untranslated region of human phospholipase A2 group V of SEQ ID NO: 3 as now claimed. Therefore, this reference, either alone or when combined, fails to teach the limitations of the claims as amended.

The secondary references cited, when combined with the primary references, fail to overcome the deficiencies in teaching of these primary references.

As acknowledged by the Examiner, Balboa et al. (1996) disclose

only antisense to mouse phospholipase A2 group V, not antisense compounds of any type targeted to any region within the human gene as claimed. Accordingly this reference, either alone or when combined with the primary reference, fails to teach or suggest the limitations of the claims as amended.

Taylor et al. (1999) disclose a method for systematically screening antisense compounds to understand gene function. Although this reference discusses how antisense compounds can be screened for activity, nowhere does this paper teach or suggest that antisense compounds targeted to a specific nucleobase region within the 3'-untranslated region of the sequence of human phospholipase A2 group V (SEQ ID NO: 3)can be used to successfully inhibit gene expression in cells as claimed.

Baracchini et al. (US Patent 5,801,154) disclose the use of antisense compounds to modulate expression of multi-drug resistance-associated protein. However, nowhere does this paper teach or suggest that antisense compounds targeted to a specific nucleobase region within the sequence of human phospholipase A2 group V (SEQ ID NO: 3)can be used to successfully inhibit gene expression in cells as claimed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. MPEP 2143. First, there must be some

suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art must teach or suggest all claim limitations. Clearly, the art as combined fails to teach the limitations of the amended claims which recite antisense compounds targeted to a specific nucleobase region within 3'-untranslated region of the sequence of human phospholipase A2 group V (SEQ ID NO: 3), a region that was not suggested by any of the cited references, either alone or when combined. Further, the combined art fails to provide one of skill with either the expectation of success or the motivation to combine the teachings. It is only with the specification in hand that one of skill would understand how to make and use compositions of the instant invention which are antisense compounds targeted to a very specific region within the sequence of SEQ ID NO: 3. MPEP 2143.01 states that the mere fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. There must some suggestion or motivation in the reference to do so. Such suggestion or motivation is clearly lacking in the combination of references cited. Accordingly, withdrawal of this rejection is respectfully requested.

II. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

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